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In re Application of
Clark et al.

Application No.: 10/585,261

PCT No.: PCT/US2005/000638

Int. Filing Date: 07 January 2005

Priority Date: 07 January 2004

Attorney's Docket No.: 10159NP

For: BIOMARKERS AND METHODS...
FACTOR RECEPTOR MODULATORS

: DECISION ON

: PETITION UNDER

: 37 CFR 1.137(a)

This decision is in response to applicant's "Petition For Revival Of An Application For Patent Abandoned Unavoidably Under 37 CFR 1.137(a)," filed on 18 June 2009.

BACKGROUND

On 07 January 2005, applicants filed international application PCT/US2005/000638, which claimed priority of an earlier application filed 07 January 2004.

On 05 July 2006, applicants filed a Transmittal Letter for entry into the national stage in the United States of America. Filed with the Transmittal Letter was, inter alia, the requisite basic national fee. No oath or declaration of the inventors accompanied the transmittal letter.

On 24 October 2008, the United States Designated/Elected Office (DO/EO/US) mailed a "NOTIFICATION OF MISSING REQUIREMENTS UNDER 35 U.S.C. 371 IN THE UNITED STATES DESIGNATED/ELECTED OFFICE (DO/EO/US)" (Form PCT/DO/EO/905) which informed applicant, inter alia, that an "Oath or Declaration of the inventors, in compliance with 37 CFR 1.497(a) and (b), identifying the application by the International application number and international filing date... is not executed in accordance with either 37 CFR 1.66 or 37 CFR 1.68." The Notice stated that the declaration must be submitted within two months from the date of this notice or 32 months from the priority date, whichever is later, in order to avoid abandonment of the national stage application.

On 15 May 2009, a Notification of Abandonment was mailed to petitioner. It stated that the applicant has failed to respond to the notification of Missing Requirements (Form PCT/DO/EO/905), mailed 10/24/08 within the time period set therein.

On 18 June 2009, petitioner filed the instant petition accompanied, inter alia, with an executed declaration.

DISCUSSION

A grantable petition to revive an abandoned application under 37 CFR 1.137(a) must be accompanied by: (1) The reply required to the outstanding Office action or notice, unless previously filed; (2) The petition fee as set forth in § 1.17(l); (3) A showing to the satisfaction of the Director that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unavoidable; and (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

The petition is not deemed to satisfy the requirements under 37 CFR 1.137(a). Petitioner has not satisfied item (3) but has satisfied items (1) and (2) under 37 CFR 1.137(a). In this application, no terminal disclaimer is required.

Petitioner has provided: (1) the proper reply by providing an executed declaration.

With respect to item (2), petitioner has provided the proper amount of the petition fee set forth in § 1.17(l).

With respect to item (3), the showing of record by petitioner is inadequate to establish an unavoidable delay within the meaning of 37 CFR 1.137(a). A petition under 37 CFR 1.137 cannot be granted unless it meets the minimal unintentional delay threshold. That is, an intentional delay precludes revival under either 37 CFR 1.137(a) (i.e., unavoidable delay), or 37 CFR 1.137(b) (i.e., "unintentional delay"). See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat 1988). The analysis will be based on the standard of Withdrawing Holding of Abandonment.

MPEP section 711.03(c) establishes the requirement to show nonreceipt of an Office action. It states that:

"The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. See Notice entitled "Withdrawing the Holding of Abandonment When Office Actions Are Not Received," 1156 O.G. 53 (November 16, 1993).

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

A review of the petition reveals that petitioner has not complied with the requirements set forth in section 711.03(c), which requires a copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed for reply. Petitioner's copy of the office's docket report is insufficient to establish failure to receive the Office communication because petitioner has not provided a copy of the log showing all the mailed received during the time period the office communication would have been received (time period between October 24, 2008 and October 30, 2008). Laura Caponi states that she searched the docket system for all dates from January 7, 2005 to May 15, 2009 and found no record of the receipt of the Notice of Missing Requirements, however no evidence was submitted as stated above such as the log showing mailed received from the USPTO between October 24, 2008 and October 30, 2008. Also, petitioner has not provided a tickler sheet for the time period around 24 December 2008. In other words, to establish a showing nonreceipt of the Notification of Missing Requirements would require, a copy of both the docket report showing all replies docketed for a date of two months from the mail date of the nonreceived Office action, which was around 24 December 2008 and a log showing all the mailed received from the USPTO during the time period the office communication would have been received.

Accordingly, petitioner has not met the requirements under MPEP section 711.03(c) to establish nonreceipt of an Office action, and the withdrawal of abandonment of the above captioned-application at this time is not appropriate.

As such, the petition is deemed not to satisfy item (3) under 37 CFR 1.137(a).

CONCLUSION

For the reasons above, the petition to revive under 37 CFR 1.137(a) is **DISMISSED** without prejudice.

The application remains **ABANDONED**.

If reconsideration on the merits of this petition is desired, a proper reply must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.137(a)."

Any further correspondence with respect to this matter should be addressed to the Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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